

REMARKS

In the final Office Action mailed August 23, 2007, the Examiner noted that claims 1-3, 7 and 12-22 were pending, and rejected all claims. New claims 24 and 25 have been added and, thus, in view of the forgoing claims 1-3, 7 and 12-25 remain pending for which reconsideration is requested. No new matter has been added. The Examiner's rejections are traversed below.

On page 5 of the Office Action, the Examiner rejected all claims under 35 U.S.C. § 102 as anticipated by Smith. As evidenced by the Declaration executed on June 4, 2007, Smith is not prior art. The final Office Action disputes the adequacy of the evidence submitted, however, and states that the June 4, 2007 Declaration and Attachments filed on June 11, 2007 "have been considered but they are ineffective to overcome the applied reference[]" (page 3, numbered paragraph 1). Briefly, the final Office Action alleged the following three deficiencies in the June 4, 2007 Declaration and Attachments: (1) the evidence submitted was deemed insufficient to establish conception, (2) the evidence submitted was deemed insufficient to show due diligence and (3) the evidence submitted was deemed insufficient to shown the applicant was in possession of all the limitations prior to April 25, 1995. Each allegation in the final Office Action is traversed in turn below. Reconsideration is respectfully requested.

On page 5 the final Office Action alleges, with reference to numbered paragraph 2 in the June 4, 2007 Declaration, that "this concept was only implemented on a single (or local) computer" (lines 13-14) and based on this assertion, the final Office Action concludes "the Applicant did not know how to make the concept working [*sic*] as claimed 'a pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location'"(lines 15-16). This analysis of the June 4, 2007 Declaration presented in the final Office Action had two principal shortcomings: the June 4, 2007 Declaration did not state or suggest "this concept was only implemented on a single (or local) computer", as asserted by the final Office Action; and the final Office Action does not provide any evidence supporting its conclusion that the claimed "pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location" was unsupported by the June 4, 1995 Declaration. To emphasis this point, numbered paragraph 2 from the June 4, 2007 Declaration is reproduced below, in its entirety:

Prior to March 9, 1995 I conceived of a menu selection system including a display displaying a menu comprising a radial marking menu portion simultaneously displayed with a linear menu portion where a pointing device is used for indicating a type of selection by making a stroke or mark with a direction and designating a location

and including a computer connected to the display and the pointing device, and determining selection criteria for the type and a menu item selection based on a method of selection from the stroke or location. On or about March 9, 1995 I documented this conception in my hardbound notebook as shown in Attachment A.

(emphasis added). Not only is paragraph 2 of the June 4, 2007 Declaration silent with respect to a local computer, the final Office Action dismissed, without justification or explanation, the explicit statement "Prior to March 9, 1995 I conceived ... a pointing device is used for indicating a type of selection by making a stroke or mark with a direction and designating a location" made in the signed June 4, 1995 Declaration.

In light of the statements made by the inventor and the final Office Action's complete failure to rebut the evidence provided therein, the conclusion made by the final Office Action, namely that the evidence submitted was deemed insufficient to establish conception, was not warranted and it is submitted that the evidence filed on June 11, 2007 does indeed establish conception prior to April 25, 1995.

On page 6 the final Office Action concludes that "the evidence submitted is also insufficient to establish due diligence from a date prior to the date of reduction to practice of Smith and to either a constructive reduction or an actual reduction to practice" (lines 17-19) and specifically alleged of "periods of lacking activity in the Attachments without any explanation such as periods of 2 months between April 28, 1995 and June 6, 1995" (page 6, lines 16-18), presumably as the rationale for its conclusion. For a second time the final Office Action has dismissed the signed June 4, 2007 Declaration. Primarily, numbered paragraph 2 describes activity prior to April 25, 1995 (the Smith reduction to practice date) while numbered paragraphs 4-7 described activity after April 25, 1995 but prior to June 6, 1995. These statements by the inventor are further evidence by the work reports of Mr. Beckers, submitted as Attachment D on 11, 2007.

Therefore, in light of the statements made in by the inventor and submitted documentation, coupled with the final Office Action's second complete failure to rebut the evidence provided therein, the conclusion made by the final Office Action, namely that the evidence submitted was deemed insufficient to show due diligence, was not warranted and it is submitted that the evidence filed on June 11, 2007 does indeed show due diligence prior to April 25, 1995 to June 6, 1995.

On page 6 the final Office Action concludes that

there is not [*sic*] explanation of the exhibits or positive statement on the declaration to support the limitation "a display displaying a menu comprising a radial marking menu portion simultaneously displayed with a linear menu portion a pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location; and a computer connected to said display and said pointing device, and determining selection criteria for the type and a menu item selection based on a method of selection from the one of the stroke and the location"

on page 8, lines 3-11. In response, the Examiner is urged to review numbered paragraph 2 from the June 4, 2007 Declaration, which positively states on lines 1-6 what the final Office Action alleged was absent.

Therefore, in light of the statements made in by the inventor and the final Office Action's third complete failure to rebut the evidence provided therein, the conclusion made by the final Office Action, namely that the evidence submitted was deemed insufficient to shown the applicant was in possession of all the limitations prior to April 25, 1995, was not warranted and it is submitted that the evidence filed on June 11, 2007 does indeed show possession of all the claimed limitations.

Moreover, even if Smith were taken as prior art, the final Office Action failed to provide *prima facie* evidence that Smith anticipates the pending claims. In rejecting the claims under section 102, the Examiner conceded Smith failed to "teach two different portions of radial marking menu and linear menu" (page 3, lines 11-12) and merely stated "it was well known in the computer arts to implement the two different menu portions" (page 3, lines 12-13). The final Office Action, however, failed to adequately provide any evidence of common knowledge. As stated in section 2144.03 of the Manual of Patent Examining Procedure, the when Official Notice is taken that is unsupported by documentary evidence, the "examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge" (*citing Soli*, 317 F.2d 941, 946, 37 USPQ 797, 801 (CCPA 1963) *and Chevenard*, 139 F.2d 711, 713, 60 USPQ, 239, 241 (CCPA 1943)).

Since the final Office Action failed to "provide specific factual findings predicated on sound technical and scientific reasoning", but merely asserts "it was well known in the computer arts to implement the two different menu portions", it is submitted that the final Office Action has *not* adequately demonstrated that Smith anticipates the pending claims because Smith fails to teach two different portions of radial marking menu and linear menu.

New claim 24 recites "the pointing device allowing a user to select by both making a

stroke and designating a location and for indicating a type of selection by the user making one of a stroke having a direction for radial marking menu selection and designating a location" at lines 1-4. Nothing in the prior art teaches or suggests such. It is submitted that this new claim, which is different and not narrower than prior filed claims distinguishes over the prior art.

New claim 25 recites "the pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location local to both the display and the pointing device" at lines 1-3. Nothing in the prior art teaches or suggests such. It is submitted that this new claim, which is different and not narrower than prior filed claims distinguishes over the prior art.

It is submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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